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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,065	08/07/2003	Robert G. Korneluk	110-C1	1523
49580 7590 03/29/2007 PHILIP SWAIN, PHD C/O GOWLING LAFLEUR HENDERSON 1 PLACE VILLE MARIE, 37TH FLOOR MONTREAL, QC H3B 3P4 CANADA			EXAMINER ZARA, JANE J	
			ART UNIT 1635	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 03/29/2007	DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/636,065

Applicant(s)

KORNELUK ET AL.

Examiner

Jane Zara

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1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: SEQ alignment data.

## **DETAILED ACTION**

This Office action is in response to the communication filed 2-7-07.

Claims 1-9 are pending in the instant application.

### ***Response to Arguments and Amendments***

#### **Withdrawn Rejections**

Any rejections not repeated in this Office action are hereby withdrawn.

#### **New Rejections**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Bennett et al (USPN 6,087,173).

Bennett et al (USPN 6,087,173) teach an XIAP oligonucleotide comprising or consisting of SEQ ID NO. 29, which oligonucleotide optionally comprises between 8-30 nucleobases in length and is targeted to SEQ ID NO. 1, encoding human X-linked

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inhibitor of apoptosis, and which oligonucleotide optionally comprises RNA residues as a subset of nucleobases, phosphorothioate modified internucleotide linkages, 2'-O-methoxyethyl modified sugars, including at one or more positions on the flanking 5' and 3' termini, and is optionally a chimeric oligonucleotide (see abstract, col. 1-2, col. 5-10, claim 1, SEQ ID NO. 11, and accompanying sequence alignment data).

### ***Conclusion***

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. ' 1.6(d)). The official fax telephone number for the Group is 571-273-8300. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

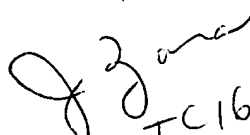
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Zara whose telephone number is (571) 272-0765. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas Schultz, can be reached on (571) 272-0763. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (571) 272-0564. Any inquiry of a general nature or relating

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to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Jane Zara**  
**3-22-07**

  
TC 1600  
JANE ZARA, PH.D.  
PRIMARY EXAMINER

1082

Se Q  
Alignment  
DATA

VERSION AR103291.1 GI:12814879  
 KEYWORDS .  
 SOURCE Unknown.  
 ORGANISM Unknown.  
 Unclassified.  
 REFERENCE 1 (bases 1 to 20)  
 AUTHORS Bennett,C.Frank., Ackermann,E.J. and Cowser,L.M.  
 TITLE Antisense modulation of X-linked inhibitor of apoptosis expression  
 JOURNAL Patent: US 6087173-A 11 11-JUL-2000;  
 FEATURES Location/Qualifiers  
     source 1. .20  
             /organism="unknown"  
             /mol\_type="unassigned DNA"

## ORIGIN

Query Match 100.0%; Score 19; DB 2; Length 20;  
 Best Local Similarity 100.0%; Pred. No. 33;  
 Matches 19; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 1 ATCTTCTCTTGAAAATAGG 19  
     |||||  
 Db 2 ATCTTCTCTTGAAAATAGG 20

RESULT 4  
CQ890068

LOCUS CQ890068 33 bp DNA linear PAT 19-OCT-2004  
 DEFINITION Sequence 22 from Patent WO2004085660.  
 ACCESSION CQ890068  
 VERSION CQ890068.1 GI:54305762  
 KEYWORDS .  
 SOURCE synthetic construct  
 ORGANISM synthetic construct  
 other sequences; artificial sequences.  
 REFERENCE 1  
 AUTHORS Smith,J.F., Kamrud,K. and Rayner,J.O.  
 TITLE Improved alphavirus replicons and helper constructs  
 JOURNAL Patent: WO 2004085660-A 22 07-OCT-2004;  
 Alphavax, Inc. (US)  
 FEATURES Location/Qualifiers  
     source 1. .33  
             /organism="synthetic construct"  
             /mol\_type="unassigned DNA"  
             /db\_xref="taxon:32630"  
             /note="PCR primer"

## ORIGIN

Query Match 100.0%; Score 19; DB 2; Length 33;  
 Best Local Similarity 100.0%; Pred. No. 31;  
 Matches 19; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 1 ATCTTCTCTTGAAAATAGG 19  
     |||||  
 Db 5 ATCTTCTCTTGAAAATAGG 23

## RESULT 5

CS027754/c  
 LOCUS CS027754 19 bp RNA linear PAT 03-MAR-2005  
 DEFINITION Sequence 7 from Patent WO2005014811.  
 ACCESSION CS027754

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SOURCE Unknown.  
 ORGANISM Unknown.  
 Unclassified.  
 REFERENCE 1 (bases 1 to 19)  
 AUTHORS Korneluk,R.G., LaCasse,E., Baird,S., Holcik,M. and Young,S.  
 TITLE Antisense IAP nucleic acids and uses thereof  
 JOURNAL Patent: US 6673917-A 22 06-JAN-2004;  
 University of Ottawa; Ottawa;  
 CAX;

FEATURES Location/Qualifiers  
 source 1. .19  
 /organism="unknown"  
 /mol\_type="genomic DNA"

## ORIGIN

Query Match 100.0%; Score 19; DB 2; Length 19;  
 Best Local Similarity 100.0%; Pred. No. 33;  
 Matches 19; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 1 ATCTTCTCTTGAAAATAGG 19  
 |||||  
 Db 1 ATCTTCTCTTGAAAATAGG 19

## RESULT 2

AX411922

LOCUS AX411922 19 bp DNA linear PAT 14-JUN-2002

DEFINITION Sequence 22 from Patent WO0226968.

ACCESSION AX411922

VERSION AX411922.1 GI:21444387

KEYWORDS .

SOURCE synthetic construct

ORGANISM synthetic construct

other sequences; artificial sequences.

REFERENCE 1

AUTHORS Korneluk,R.G., Lacasse,E., Baird,S., Holcik,M. and Young,S.

TITLE Antisense iap nucleic acids and uses thereof

JOURNAL Patent: WO 0226968-A 22 04-APR-2002;

University of Ottawa (CA) ; Aegera Therapeutics Inc. (CA)

FEATURES Location/Qualifiers

source 1. .19  
 /organism="synthetic construct"  
 /mol\_type="unassigned DNA"  
 /db\_xref="taxon:32630"  
 /note="based on Homo sapiens"

## ORIGIN

Query Match 100.0%; Score 19; DB 2; Length 19;  
 Best Local Similarity 100.0%; Pred. No. 33;  
 Matches 19; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 1 ATCTTCTCTTGAAAATAGG 19  
 |||||  
 Db 1 ATCTTCTCTTGAAAATAGG 19

## RESULT 3

AR103291

LOCUS AR103291 20 bp DNA linear PAT 14-FEB-2001

DEFINITION Sequence 11 from patent US 6087173.

ACCESSION AR103291